



Docket No. KCC-16270

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: S. Scott FRIDERICH et al.

Serial No.: 10/024,634

Filing Date: 17 December 2001

Title: BODY FLUID SEALING GASKETS FOR
PERSONAL CARE PRODUCTS

Customer No.: 35844

Group No.: 3761

Examiner: J. Stephens

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets, of which there are not more than five.

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450 on

21 NOVEMBER 2005

21 NOV 05
Date

Rolando Morris
Signature

REMARKS

Applicants request that the panel review the legal and factual insufficiencies of the following rejections contained in the final Office Action of 29 June 2005, as set forth in the final Office Action thereof.

Claim Rejections -35 USC § 112

Per paragraph 5, page 5 of the final Office Action, Claims 1, 2, 4-6, 8-10, 14-19 and 21-25 are rejected under 35 USC § 112, first paragraph, as containing subject matter not sufficiently described in the specification, owing to: "The test procedures for determining a Young's modulus and a modulus of elasticity as recited in claims 1, 8, and 9 are not enabled by the disclosure. The test characteristics cited in the application do not include the test procedures."

The factual basis of this rejection is clearly in error.

Applicants further contend the Examiner has not provided sufficient factual findings with respect to the ordinary level of skill in the art to support a *prima facie* case for this rejection. Applicants further contend that no reasonable findings with respect to the ordinary level of skill in the art could support a *prima facie* case for this rejection sufficient to overcome the strong presumption that the application is enabling to a person having ordinary skill in the art.

Applicants refer the panel to their discussion of the legal and factual sufficiency of the test procedures complained of in this rejection as contained in Applicants' Request for Reconsideration filed 29 August 2005, at pages 2-3 (1st five paragraphs under the heading "Claim Rejections -35 USC § 112") and the corresponding arguments at Applicants' Amendment C filed 03 November 2004 at pages 8-9 (under the heading "Allowable Subject Matter") and pages 10-11 (1st two paragraphs under the heading "Claim Rejections -35 USC § 112"). Applicants again assert that those of ordinary skill would understand with reasonable certainty how to practice the present invention.

The panel is further requested, in fairness to the Applicants, to review the irregularity of the examination of the present invention wherein the Office's response of 24 March 2005 to Applicants' Amendment C made no further mention of the §112 rejections but was merely a restriction requirement. After Applicants' election per their Amendment D filed 13 April 2005, the §112 rejections were resurrected in the final Office Action of 29 June 2005.

Per paragraph 6, page 5 of the final Office Action, Claims 1, 2, 4-6, 8-10, 14-19 and 21-25 are rejected under 35 USC § 112, first paragraph: "because the specification, while being enabling for the embodiments taught in examples 1 and 2 on page 26 of the disclosure, does not: "reasonably provide enablement for other types of materials or combinations of construction." and further: "fails to teach one of ordinary skill in the art the exact film needed or the exact process for forming the nonwoven web to provide the claimed test results. [emphasis added]"

Both the legal basis and the factual basis of this rejection are clearly in error. The Office has imposed an undue burden upon the Applicants to inform the public of every material meeting the claim language.

Applicants refer the panel to their discussion of the legal and factual sufficiency of the specification in refuting this rejection at Applicants' Request for Reconsideration filed 29 August 2005, at page 3, 3rd paragraph, to page 5; and the corresponding arguments at Applicants' Amendment C filed 03 November 2004 at page 11, 1st paragraph, to page 13, 1st paragraph. Applicants again assert that those of ordinary skill would understand with reasonable certainty how to practice the present invention.

The structure and function of the present invention are adequately explained to enable a person having ordinary skill in the present art to make and use the claimed invention(s). The structure to achieve the different Young's Modulus in different axes, and the functional benefits from such structure, are all adequately explained in the specification. It is long settled law that the specification need not teach every conceivable embodiment encompassed by the claims. It is further well settled that

Applicants are not required to provide an exact manufacturing specification of the type apparently being required by the Examiner in the present instance. In short, the Examiner seeks to impose extra-legal requirements upon the present application which cannot be allowed to stand.

Claim Rejections -35 USC §103

In general, the Examiner has attempted to force the Applicants into the untenable position of having to prove a negative with respect to each lack of teaching of the prior art. Applicants believe that in so far as possible under this stricture, they have provided sufficient argument that a *prima facie* case has not been made by the Office. Further, when viewed as a whole, and without benefit of hindsight, the patentability and contribution to the art of the present invention are evident.

Per paragraph 9, page 6 of the final Office Action, Claims 1, 2, 4 and 8 stand rejected as obvious over McCormack, US Patent 5,855,999 (hereinafter "McCormack").

The factual basis and legal conclusions of this rejection are clearly in error. Applicants contend that the Examiner has not provided sufficient findings drawn from the art itself to support a *prima facie* case for this rejection. Any suggestion that McCormack makes the presently claimed invention obvious, merely through the use of similar starting materials at some generic level, would require impermissible hindsight to achieve the present invention. Applicants refer the panel to their discussions of the insufficiency of this rejection as contained in Applicants' Request for Reconsideration at page 6, 3rd and 4th paragraphs; Amendment C at pages 13-14; and Amendment A, filed 12 January 2004, at pages 8-10.

Per paragraph 10, page 8 of the final Office Action, Claims 1, 6, 9, 10, 15, 16 and 25 stand rejected as obvious over Buell (US Patent 5,085,654 hereinafter "Buell").

The factual basis and legal conclusions of this rejection are clearly in error. Applicants contend that the Examiner has not provided sufficient findings drawn from the art itself to support a *prima facie* case for this rejection. Applicants refer the panel to their discussions of the insufficiency of this rejection as contained in Applicants' Request for Reconsideration page 7, 2nd paragraph; Amendment C page 14, last paragraph; and Amendment A filed 12 January 2004, pages 8-10.

Per paragraph 11, page 11 of the final Office Action, Claim 5 is rejected as obvious over McCormack in view of Morman, US Patent 5,226,992 (hereinafter "Morman").

The factual basis and legal conclusions of this rejection are clearly in error. Applicants contend that the Examiner has not provided sufficient findings drawn from the art itself to support a *prima facie* case for this rejection. Applicants refer the panel to their discussions of the insufficiency of this rejection as contained in Applicants' Request for Reconsideration at page 7, last two paragraphs; Amendment C at page 15, 1st paragraph; and Amendment A at page 10, last paragraph.

Per paragraph 12, page 12 of the final Office Action, Claims 9, 11-12, 14, and 17-24 are rejected as obvious over McCormack in view of Sauer (US Patent 5,938,652, hereinafter "Sauer").

The factual basis and legal conclusions of this rejection are clearly in error. Applicants contend that the Examiner has not provided sufficient findings drawn from the art itself to support a *prima facie* case for this rejection. Applicants refer the panel to their discussions of the insufficiency of this rejection as contained in Applicants' Request for Reconsideration at page 8, 1st paragraph; Amendment C at page 16, 1st paragraph; and Amendment A at page 11, last paragraph.

Conclusion

Applicants request that the panel, upon review and understanding of the clear errors and insufficiencies of the final Office Action of 29 June 2005, find for the Applicants concerning each of the above rejections.

Favorable consideration is requested.

Respectfully submitted,



Roland W. Norris
Registration No. 32,799

Pauley Petersen & Erickson
2800 West Higgins Road; Suite 365
Hoffman Estates, Illinois 60195
TEL (847) 490-1400
FAX (847) 490-1403